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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,532	08/27/2003	Stuart L. Schreiber	2001180-0077	7136
24280	7590	03/10/2006	EXAMINER	
CHOATE, HALL & STEWART LLP TWO INTERNATIONAL PLACE BOSTON, MA 02110			SOLOLA, TAOFIQ A	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/649,532

Applicant(s)

SCHREIBER ET AL.

Examiner

Taofiq A. Solola

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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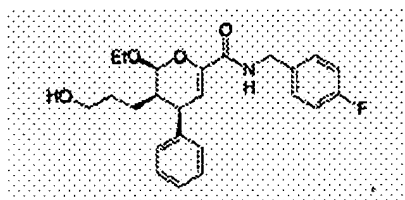
Claims 1-30 are pending in this application.

Claims 31-39 are cancelled.

RESTRICTION REQUIREMENT

Applicant's election of group I, claims 1-30, without traverse in the Paper filed 6/13/05 is hereby acknowledged.

In selecting the invention of group I, applicant also elects the following species:



Status of Claims

The Office has reviewed the claims and disclosure to determine the scope of the independent invention encompassing the elected compound (compounds which are so similar thereto as to be within the same inventive concept and reduction to practice). The scope of an independent invention encompasses all compounds within the scope of the claims, which fall into the same class and subclass as the elected compound, but may include additional compounds, which fall in related subclasses. Examination of the elected compound AND the entire scope of the invention encompassing the elected compound as defined by common classification results in the following:

In formula I, R3 is phenyl which may be substituted or form polycyclic rings, limited to those defined in the claims. R1-R2, R4-R6 are as defined in claim 1. As a result of the election and the corresponding scope of the invention identified herein, the remaining subject matter of claims 1-30, are withdrawn from further consideration by the Examiner, under 37 CFR §

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1.142(b), as being drawn to a non-elected subject matter. The withdrawn compounds are patentably distinct from the examined invention as they differ in structure and element and would require a separate search. In addition, a reference, which anticipates the examined invention, would not render obvious the non-examined subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recite the definition of R7 on line 6 but there is no R7 in formula I.

Claim 2 recites R5 on line 5, while there is no R5 in formula II. Therefore, claims 1-14, 23-30 are indefinite.

Claims 23-25 improperly depend from their independent claims for failure to limit the scope of the independent claims. Claim 23 may contain (one or more) all the compounds of claim 1 or 2, and therefore fails to limit the scope of claim 1 or 2. Claims 23-25 are drawn to the same collection of compounds while claims 24-25 recite the compounds are in array format. Characterization such as, arrangement, function, or utility is not a limitation of a compound or product, and the compounds are the same in the claims. For example, see *In re Best* 562 F.2d 1252, 1254; 195 USPQ 430 (CCPA, 1977). By deleting the claims the rejection would be overcome.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-16, 23-29 are rejected under 35 U.S.C. 102(a) as being anticipated by Blackwell et al., Angew. Chem. Int. Ed. (2001) Vol. 40, No. 18, pages 3421-3425.

Blackwell et al., disclose combinatorial library of compounds in the attached abstract.

Claims 1-14, 23-30 are rejected under 35 U.S.C. 102(a) as being anticipated by Clemons et al., Chem. & Biol. (2001) Vol. 8, No. 12, pages 1183-1195.

Clemons et al., disclose composition of library of compounds in the attached abstract.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blackwell et al., Angew. Chem. Int. Ed. (2001) Vol. 40, No. 18, pages 3421-3425.

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Applicant claims a collection of compounds of claim 1. In preferred embodiments the compounds are two or more, at least 100, 1000, 2000 or 10,000. The compounds are arranged in array format on a glass.

Determination of the scope and content of the prior art (MPEP 2141.01)

Blackwell et al., teach combinatorial library of compounds in the attached abstract.

Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)

The difference between the instant invention and that of Blackwell et al., is that applicant claims the compounds are two or more, at least 100, 1000, 2000 or 10,000. The compounds are arranged in array format on a glass while Blackwell et al., do not teach specific minimum number of the compounds.

Finding of prima facie obviousness---rational and motivation (MPEP 2142.2413)

However, applicant merely stated the minimum not the maximum and the maximum could have been the same as that of Blackwell et al. Even then, specifying the number of compounds in a collection/library and arranging them in array format are not patentable significant, and are not patentable over the prior art of Blackwell et al. Therefore, the instant invention is prima facie obvious from the teaching of Blackwell et al. One of ordinary skill in the art would have known to claim the minimum number of compounds in a library at the time this invention was made. The motivation is from the teaching of Blackwell et al., that the compounds are a collection.

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Applicant's arguments filed 1/5/06 have been fully considered but they are not persuasive. Applicant contends that Stuart Schreiber, one of the instant inventors, is an author of the cited prior arts, and that none of the prior arts relates to the instant compounds. This is not persuasive for reasons set forth above. Applicant should read the statutes above.

Allowable Subject Matter

Claims 17 and 22 are allowable over prior arts of record. Claims 18-21 are being withdrawn and should be cancelled. See Status of Claims, *supra*. In addition to overcoming the prior arts, claims 1-14, 23-30 should be amended within the scope of allowable subject matter as stated under Status of Claims, *supra*.

Drawing

Figures 23-25 filed 8/27/03 are objected to because the legends are hand-written. New figures with printed legends must be submitted.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, JD, whose telephone number is (571) 272-0709.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

A handwritten signature in black ink, appearing to read 'Solola', with a stylized flourish at the beginning.

TAOFIQ SOLOLA
PRIMARY EXAMINER
Group 1626

March 6, 2006